

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: :
David John Parkinson : Group Art Unit: 3753
Serial No.: 10/553,080 : Confirmation No. 2720
PCT No. PCT/GB04/001351 : Examiner:
International Filing Date: 31 March 2004 : Docket No.: DPS-030807 PET-1013US
Priority Date: 10 April 2003 :
For: FILTRATION APPARATUS : Date: August 7, 2007

**RENEWED PETITION IN SUPPORT OF
APPLICATION FILED UNDER 37 CFR §1.47(b)**

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Office of PCT Legal Administration
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This is a second Renewed Petition for acceptance of an application where the sole inventor refuses to execute the application for patent.

Ms. Erin P. Thomson, Attorney Advisor for PCT Administration, issued a Decision on Petition under 37 CFR §1.47(b) dated 08 June 2007 setting a period for response of 2 months. Of the items (1) through (6) addressed therein, Ms. Thomson kindly found that items (1), (2), (3), (4) and (6) had been met, for which the Applicant is very appreciative. Ms. Thomson found that item (5) has not been satisfied. Item

(5) relates to proof that the 37 CFR §1.47(b) applicant has sufficient proprietary interest in the application.

In further support of the Petition, the following is presented, in addition to the previous submissions filed 23 February 2007 and 05 September 2006:

- A copy of an email from inventor David Parkinson to Ashley Giles dated 23 March 2004 (Exhibit F).

Item (5)

Ms. Thomson finds that the legal memorandum relies on an employment agreement executed by Mr. Parkinson, but that employment agreement has not been included with this submission, and that the Applicant has still not provided the agreement.

Ms. Thomson found that the Applicant claimed it was relying on the “Statement of Inventorship and right of grant to a patent” filed with the British Patent Office, and that such was a certified statement of inventorship. Ms. Thomson notes that this statement is for the British priority application, not the international application, and that it is not clear what research was put into making this statement, to what certification the Applicant refers, who signed the statement and it is not clear that the person who signed the statement had firsthand knowledge of the facts recited therein. Further, Ms. Thomson finds that ownership by virtue of employment is a legal conclusion, and that the Applicant has been asked to establish this through a legal memorandum with the necessary supporting documentation, but that the statement does not satisfy the United States Patent and Trademark Office’s requirements of proof of sufficient proprietary interest.

Finally, Ms. Thomson noted that the Applicant was previously informed that the submission lacked a statement of someone with firsthand knowledge that this invention was made by Mr. Parkinson, while employed by DPS. Ms. Thomson admits that Mr. Parkinson comes close, but he does not specifically indicate that “Filtration Apparatus” was made while employed by DPS. Ms. Thomson finds the

statement by Paul Webb insufficient because items (4) and (5) from the statement do not demonstrate Mr. Webb's firsthand knowledge that Mr. Parkinson made the invention within the scope of his employment.

In response thereto the Applicant respectfully submits the attached copy of an email from the inventor David Parkinson to a Mr. Ashley Giles dated 23 March 2004 (Exhibit F). From the context of the entire 3-page email, it may be deduced that Mr. Giles is a UK patent attorney helping Mr. Parkinson and DPS Ltd. secure patent rights in the various inventions detailed therein. The Applicant would respectfully and particularly direct Ms. Thomson's attention to the last paragraph thereof, where Mr. Parkinson stated: "I would also be interested in knowing exactly where we stand with *the DynaSep media filter patent* and to which end I think on my return from India we should have our long muted meeting in Portishead to review all aspects of our patent portfolio." (Emphasis added.)

The DynaSep media filter patent is the UK and/or PCT International Patent Application corresponding to the above-identified patent application. Proof of this is seen in the Agreement dated 1 September 2004 between DPS and KCC Group Limited (Exhibit C) of the original Petition filed 05 September 2007, page 15, where "Dyna-Sep" is correlated with UK application number 0308291.4 with a 10.04.2003 date of filing.

The Applicant in their Petition and Renewed Petition has established an unbroken transfer of the rights in the subject invention from the inventor Mr. Parkinson to DPS, and in turn from DPS to KCC Group Limited, the present Applicant, to establish sufficient proprietary interest.

The Applicant has been diligently searching for an employment agreement executed by Mr. Parkinson, but has not found one and can only conclude that one does not exist. One does not exist because under UK law one is not required as it is in the United States. That such an employment agreement is unnecessary is established by the Legal Memorandum of Noel J. Akers, previously submitted. In the middle of page 4 of that Legal Memorandum, Mr. Akers states: "It is concluded that,

by virtue of section 39(1)(a) of the Act, all right and title in the invention vested in DPS.” Mr. Akers reaches this conclusion based on the facts as he outlines them previous to this conclusion, as well upon Section 39 of the United Kingdom Patents Act 1977, as amended up to May 2006, a copy of which was attached to his Legal Memorandum.

Mr. Akers finds later on page 4 of his Legal Memorandum that *confirmation* of this conclusion is found in the file wrapper of the priority application, GB 0308291.4. He notes:

The statement of inventorship and of right to grant of a patent dated 20 May, 2003, and filed on behalf of DPS by its agent on 22 May, 2003, with the United Kingdom Patent Office in respect of the priority application names David John Parkinson as the sole inventor. The statement of inventorship and of right to grant of a patent specifically states that the applicant, DPS, derived the right from the inventor, Mr. Parkinson, to be granted a patent as follows:

By virtue of employment of the inventor by the applicant

DPS’s agent, Ashley Giles, signing for his firm Haseltine Lake, on 20th May 2003 would certainly have had firsthand knowledge of the facts recited therein. Ms. Thomson’s attention is again respectfully directed to the email Exhibit F herein, where the inventor Mr. Parkinson communicated with Mr. Giles about the subject Dyna-Sep invention. From the contents of the email of Exhibit F, it is established that Mr. Giles was well acquainted with the patent applications and the entire portfolio of DPS, and thus had firsthand knowledge that David Parkinson was the inventor of the subject invention by virtue of his employment by applicant DPS at the time.

In the Renewed Petition filed 23 February 2007, the Applicant respectfully submitted the original, certified statement of inventorship from the UK Patent Office dated 21 August 2006, certifying that David John Parkinson was the sole inventor of the Filtration Apparatus of Patent Application Number 0308291.4 “By virtue of employment of the inventor by the applicant”, the applicant in this case being

Dynamic Processing Solutions PLC (DPS). That the UK Patent Office certified that this was a true copy of the Statement of Inventorship Form (Form 7/77) is presented on the first, ribboned and sealed page thereof. A copy of this statement was attached to Mr. Akers' Legal Memorandum. Mr. Akers goes on near the top of page 5 of the Legal Memorandum to note:

The United Kingdom Patent Office will have provided Mr. Parkinson, as a named inventor, with a copy of the statement of inventorship filed in respect of the priority application, in order to alert him to the statements being made and provide him with an opportunity to challenge the entitlement to the patent. *No such challenge was filed by Mr. Parkinson.* (Emphasis added.)

Mr. Akers goes on to conclude that this statement of inventorship confirms his previous conclusions that all rights and title in the invention described and claimed in the subject application USSN 10/553,080 vested in DPS, and further concludes that the UK Patent Court (a division of the English High Court, Chancery Division) would award all right and title to DPS. The Applicant agrees that ownership by virtue of employment is a legal conclusion, and that such has been established by Mr. Akers' Legal Memorandum.

The Applicant has further diligently searched for someone other than Paul Webb with firsthand knowledge that Mr. Parkinson made the invention within the scope of his employment, but has not found anyone else. The Applicant respectfully submits however, that Mr. Akers' Legal Memorandum and the documents discussed therein establish that Mr. Parkinson made the invention within the scope of his employment, and that Mr. Ashley Giles serves as such a person with firsthand knowledge.

The Applicant further respectfully directs Ms. Thomson's attention to the copies of:

- The Assignment between DPS (in Administration) and KCC Group Limited (Exhibit B), and

- The Agreement dated 1 September 2004 between DPS and KCC Group Limited (Exhibit C),

which were supplied with the original Petition filed 5 September 2006.

A review of the Assignment (Exhibit B) will find that the Assignor (DPS) assigned unto the Assignee (KCC Group Limited) the full title of the Inventions disclosed in the applications given on the Schedule (page 4) attached thereto. The Schedule lists *both* of the following:

Application Number	Filing Date	Title
GB0308291.4	10 April, 2003	Filtration Apparatus
PCT/GB04/001351	31 March, 2004	Filtration Apparatus

The first document is the British priority application. The second document is the International application from which the subject US Serial No. 10/553,080 is national filed, which claims priority to both. It is thus established that all rights in both of these documents have been granted to the Applicant.

Further, the Assignment makes reference to the Agreement dated 1 September 2004 between DPS and KCC Group Limited (Exhibit C), a copy of which was also previously provided. Schedule 1, page 15, therein lists the Intellectual Property Rights, where the following was listed:

Title	Country	Application Number	Date of Filing
Dyna-Sep	United Kingdom	0308291.4	10.04.2003

This again is the British priority application. However, Ms. Thompson's attention is respectfully directed to the Assignment (Exhibit B), paragraph 3, at the bottom of page 2 thereof, which states: "In the event of any discrepancy between the terms of this Agreement and the terms of the sale agreement date 1 September 2004, the terms of the sale agreement dated 1 September 2004, shall have precedence, *excluding the schedule of patents annexed hereto.*" (Emphasis added.) Since the Schedule includes *both* the British priority application and the International application, the Applicant respectfully submits that the Schedule in the Assignment (Exhibit B) prevails, and thus the Applicant, KCC Group Limited, thus does have

sufficient proprietary interest in the application to have the present, subject application filed with the United States Patent and Trademark Office.

Ms. Thomson's attention is again respectfully directed to the Renewed Petition dated 23 February 2007 and the revised Declaration and Statement of Facts in Support of Filing on Behalf of Nonsigning Inventor and Establishing Proprietary Interest for Application Filed Under 37 CFR §1.47(b) signed by Mr. Manish B. Vyas, which further establishes the Applicant's sufficient proprietary interest – that of KCC Group Limited, the present Applicant.

Further, Ms. Thomson admits that "Mr. Parkinson comes close, but he does not specifically indicate that 'Filtration Apparatus' was made while employed by DPS." Ms. Thomson's attention is respectfully directed to Exhibit IV filed 5 September 2006 with the original Petition as an attachment to Christian Ziar's Declaration, which Exhibit IV is a 23 March 2006 email from David Parkinson to Christian Ziar stating in the first sentence thereof, "Please note that as far as I am concerned the patents you refer to were all assigned to Dynamic Processing Solutions Ltd [DPS] *at the time we were all working there*, we assisted in signing the last set of documents you sent ...". (Emphasis added.) Mr. Parkinson explicitly states that these patents were all assigned to DPS while "we were all working there", which includes Mr. Parkinson himself, and that he and others signed previous documents relating thereto. The Applicant respectfully submits that any gap left by Mr. Parkinson's own "close"ness is sufficiently bridged by the evidence previously provided and provided herein, and discussed above, and that item (5), proof that the 37 CFR §1.47(b) has sufficient proprietary interest in the application, has now been met.

Prayer for Relief

In view of these facts, the Applicant respectfully petitions that the United States Patent and Trademark Office accept the application because the inventor has refused to sign, and accept the application on behalf of one showing sufficient proprietary interest in the matter justifying such action, necessary to preserve the

rights of said party, in particular that item (5) has now also been satisfied. Ms. Thomson is invited to call the Applicant's attorney at the number below to discuss any issue relating to this matter, particularly any effort that would help progress the Petition to grant.

Fee

The petition fee has been previously paid; Ms. Thomson noted in the 21 Nov. 2006 Decision and 08 June 2007 Decision that no additional petition fee is required. However, if any additional fees are due with respect to this Petition and submissions attached hereto, the Examiner is authorized to charge such fees to the Madan, Mossman & Sriram, P.C. Deposit Account No. 13-0010 (PET-1013US).

Respectfully submitted,

Date: 08 August 2007 /David L. Mossman/

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